



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

AF
CFW

Appl. No. : 10/684,281
Appellant : Reid F. Hayhow
Filed : October 10, 2003
TC/A.U. : 3685
Examiner : Jalatee Worjloh

Confirmation No. : 3341

Docket No. : 10030552-1

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Dear Sir:

This "Reply Brief" is submitted in response to the "Examiner's Answer" mailed April 14, 2009.

Argument

Claims 14-25 should not be rejected under 35 USC 102(e) as being anticipated by Organ et al. (US Pat. No. 7,191,368; hereinafter “Organ”).

Appellant’s claim 14 recites:

14. A system comprising:
a tester to apply one or more tests to a device; and
logic, communicatively coupled to the tester, to enable one or more resources of the tester according to one or more properties of an electronic license and to create at least one log file having resource use information for one or more tests executed on the tester.

With respect to claim 14, the Examiner’s Answer asserts that claim 14 may be indefinite for being a “hybrid” claim and refers applicant to MPEP 2173.05(p)II, which states, “A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph.” However, claim 14 does not claim both an apparatus and a method for using it, as was clearly done, for example, in *IPXL Holdings v. Amazon.com, Inc.*, 430 F.2d 1377, 1384, 77 USPQ2d 1140, 1145 (Fed. Cir. 2005). Instead, claim 14 recites a “system” that comprises a “tester” and “logic”. Although the claim recites functions that are performed by the “tester” and “logic”, the claim does not recite a method of using the system, tester or logic.

The Examiner’s Answer also seems to suggest that claim 14 may not be directed to statutory subject matter. However, claim 14 recites a “tester”, which is defined in applicant’s specification as a “*machine* which is designed to precisely position the placement of logic signal transitions at very high speeds.” See, par. [0001] (Emphasis added). Furthermore, claim 14 itself recited that one or more tests are “executed *on* the tester”. Tests are not typically executed “on” software, but rather “by” software.

Although the “logic” recited in claim 14 may be part of the “operating system” or “firmware” that controls the “tester” (see, par. [0010]), applicant notes that claim 14

nonetheless recites an actual machine (i.e., a "tester") to which the "logic" is "communicatively coupled". Therefore, claim 14 is believed to recite statutory subject matter.

With respect to the Examiner's wholesale refusal to give patentable weight to any of the functional language recited in claim 14, applicant relies on the arguments in his Appeal Brief. Applicant also notes MPEP 2173.05(g), which provides examples of when functional language is appropriate and needs to be given patentable weight.

Conclusion

For the reasons provided in appellant's Appeal Brief, and the reasons provided in this Reply Brief, appellant believes claims 14-25 should be allowed.

Respectfully submitted,
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